PATENT

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Application No.	: 09/635,956	Confirmation No.	: 3714
Applicant	: Timothy C. Loose		
Filed	: August 10, 2000		
TC/A.U.	: 3714		
Examiner	: Corbett B. Coburn		
Docket No.	: 47079-00058		
Customer No.	: 30223		

REPLY BRIEF
PURSUANT TO 37 C.F.R. § 1.193(b)(1)

MAIL STOP APPEAL BRIEF—PATENTS
COMMISSIONER FOR PATENTS
P.O. BOX 1450
ALEXANDRIA, VA 22313-1450

Dear Commissioner:

This Reply Brief is submitted in response to the Examiner's Answer mailed September 23, 2003, for which the two-month date for response is November 23, 2003. This Reply Brief is being submitted prior to that date.

REJECTION OF CLAIMS 1-5, 7-23, AND 27

The Examiner's Answer maintains the §103 rejection of claims 1-5, 7-23, and 27 by focusing on the same two excerpts from the McGlone patent's Summary Section while ignoring the remainder of the McGlone patent's specification cited in the Appellant's Appeal Brief. This is improper as the law of obviousness mandates that a reference be considered as a whole. *See W.L. Gore & Assoc., Inc. v. Garlock, Inc.,* 721 F.3d 1540, 1550-51, 220 U.S.P.Q. 303, 311 (Fed. Cir. 1983) (emphasis added); *see also* M.P.E.P. § 2141.02. The Examiner's Answer refers to two different embodiments, and indicates that the Appellant's arguments are focused on an incorrect embodiment of the McGlone patent. Respectfully, a careful reading of the McGlone

patent reveals that the Examiner's Answer is incorrect in its characterization of the McGlone patent.

Specifically, the Examiner's Answer states that the McGlone patent discloses two different embodiments: (1) a first embodiment wherein one or more peripheral device drivers are stored in a memory of the master gaming controller; and (2) a second embodiment wherein configuration parameters specific to the peripheral device are stored in a memory of the peripheral controller. The Appellant respectfully submits that this is a mischaracterization of the McGlone patent for at least the following reasons.

Referring to FIG. 7 of the McGlone patent and the accompanying discussion beginning at column 15, line 6, it is clear that the above-mentioned two different embodiments are not disclosed by the McGlone patent. Rather, the master gaming controller (*e.g.*, the CPU) that stores device drivers and the peripheral controller (*e.g.*, the local microcontroller) having configuration data stored in its memory are part of the <u>same embodiment</u>. In operation of the McGlone device, the peripheral controller loads information (*e.g.*, configuration information and information that "tells the standard control microprocessor what type of slot reel peripheral it is controlling") from the peripheral controller's non-volatile memory at step 710 of FIG. 7. *See* McGlone at col. 17, lines 26-38 and lines 50-56. Later, at step 750 of FIG. 7, the McGlone master gaming controller initializes one or more drivers for the peripheral devices previously identified (at step 740) based on device information obtained from the peripheral device. *See Id.* at col. 17, lines 1-7 and 38-44. The devices identified at step 750 for which drivers are loaded by the master gaming controller are those peripheral devices that the master gaming controller itself controls during the course of the game. *See Id.* at col. 17, lines 1-7.

In light of the foregoing, it is clear that the McGlone patent teaches that configuration information is stored in the memory of the peripheral device, and <u>not</u> downloaded from the master gaming controller to the peripheral controller in the form of a driver. As such, the Appellant respectfully submits that the McGlone patent does not disclose, teach, or suggest a CPU that sends configuration data to the local microcontroller for configuring the local microcontroller to a reel spinning game conducted with the slot machine as required by the Appellant's claims 1-5, 7-23, and 27.

Furthermore, the Examiner's Answer cites a passage from col. 3, lines 34-41 of the McGlone patent stating the master gaming controller includes a memory for storing device drivers for at least some of the reel peripherals. Assuming, *argendo*, that the device drivers include "configuration data" as contended by the Examiner—a contention the Appellant flatly rejects—there is no teaching by the McGlone patent that this configuration data is sent to the local microcontroller for configuring the local microcontroller to a reel spinning game conducted with the slot machine as required by the Appellant's claims 1-5, 7-23, and 27. Rather, any device driver initiated by the CPU would configure the CPU to operate the device—there is no disclosure than this initialization would send configuration data to the local microcontroller for configuring the local microcontroller.

Claims 1-5, 7-23, and 27 require that the CPU "sends configuration data to said local microcontroller for configuring said local microcontroller to a reel spinning game conducted with the slot machine." As discussed above, the McGlone patent does not disclose, teach, or suggest that the CPU sends configuration data to the local microcontroller and, therefore, a *prima facie* case of obviousness has <u>not</u> been established. In fact, even if a *prima facie* case were established, the McGlone patent teaches away from this feature of the Appellant's claims 1-5, 7-23, and 27. *See Monarch Knitting Mach. Corp. v. Sulzer Morat GMBH,* 139 F.3d 877, 885, 45 U.S.P.Q.2d 1977, 1984 (Fed. Cir. 1998) (A prior art reference may be considered to teach away when "a person of ordinary skill, upon reading the reference, would be discouraged from following the path set out in the reference, or would be led in a direction divergent from the path that was taken by the applicant.") Thus, the Appellant respectfully submits that claims 1-5, 7-23, and 27 are patentable over the McGlone patent under 35 U.S.C. § 103(a) because the McGlone patent does not disclose, teach, or suggest the subject matter of the Appellant's claims 1-5, 7-23, and 27.

REJECTION OF CLAIMS 15, 17, 19, AND 22

Initially, the Appellant respectfully submits that claims 15, 17, 19, and 22 are patentable over the McGlone patent under 35 U.S.C. § 103(a) for at least the above-discussed reason that claims 1, 9, 12, 20 are patentable over the McGlone patent—McGlone does not disclose, teach, or suggest sending configuration data from the CPU to a local microcontroller for configuring the local microcontroller to a reel spinning game.

In the final rejection, the Examiner stated "McGlone <u>fails to specifically teach</u> communication of the status of configuration from the local processor to the CPU." *See* Dec. 20, 2002 Office Action at page 4 (emphasis added). Thus, because communicating the configuration status is not taught by McGlone—as admitted by the Examiner—the Examiner cannot maintain the position that communicating the configuration status is obvious (*i.e.,* taught) in light of the McGlone patent. *See* M.P.E.P. § 2143.03 ("To establish *prima facie* obviousness of a claimed invention, all the claim limitations must be taught or suggested by the prior art.").

In response to the Appellant's Appeal Brief, the Examiner's Answer improperly introduces new points of argument. *See* 37 C.F.R. § 1.193(a)(2) (prohibiting any new grounds of rejection in an examiner's answer); *See also* M.P.E.P. § 1208.01. The Examiner's Answer makes new points of argument in an attempt to cure the deficient obviousness rejection of these claims by introducing the following new pieces of information for the first time to be combined with the McGlone patent:

(a)   slot machine controllers require absolute accuracy for meeting the requirement of stringent regulation, and for keeping casinos from paying significant amounts of money;

(b)   casinos paying significant amounts of money is well-known problem;

(c)   it is well known to double check critical data;

(d)   one of the oldest rules of computer programming is that if a program writes a value, the program should check to see that the value was correctly written; and

(e)   checking data integrity is well known to the art and is imperative if a system is to work properly.

See Examiner's Answer at page 15. The Examiner claims for the first time that all of the foregoing are well known computer programming techniques or well known problems in the art. Initially, in accordance with M.P.E.P. § 2144.03, the Appellant traverses the Examiner's claim that these pieces of information are well known in the art. Second, these pieces of "well known" information are introduced for the first time in the Examiner's Answer. Introducing these new "well known" pieces of information and combining with the McGlone patent for the first time in the Examiner's Answer appear to constitute new bases for rejection. Any new bases for rejection

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would be improper, and should not be considered. *See* 37 C.F.R. § 1.193(a)(2); *See also* M.P.E.P. § 1208.01. Thus, the Appellant respectfully submits that claims 15, 17, 19, and 22 are patentable over the McGlone patent under 35 U.S.C. § 103(a).

REJECTION OF CLAIMS 23 AND 27

The Examiner's Answer maintains the rejection of claims 23 and 27 based upon the Examiner's "two-McGlone-embodiments" theory. As established in connection with the discussion of claims 1-5, 7-23, and 27, the McGlone patent does not disclose two embodiments wherein device drivers are stored with the CPU in one embodiment, and configuration data are stored with the peripheral controller in another embodiment. Rather, the McGlone patent discloses that these two aspects are part of the same embodiment and, thus, the McGlone patent discloses configuration data is stored with the peripheral controller. Thus, claims 23 and 27, which require, *inter alia*, that configuration data is sent from the CPU to the reel controller, are patentable over the McGlone patent for at least this reason.

Claims 23 and 27 further require, *inter alia*, "determining the type of an encoder [used for indicating reel position] with said reel controller" and "using said reel controller to compare the determined type of said encoder with said configuration data." The McGlone patent does not teach that the reel controller determines this information. Rather, this information is already known to the reel controller (*i.e.*, the peripheral controller). *See* McGlone at col. 13, lines 51-57. There is no need for the McGlone peripheral (reel) controller to determine the type of position sensors used to determine the reel position because that information is already known to the peripheral (reel) controller because it is stored in the peripheral controller's memory. Thus, the alleged motivation for modifying the McGlone patent—the necessity to determine the type of encoder to determine which of the various device drivers to download—does not exist because the type of encoder is <u>already known</u> to the McGlone reel controller, which obviates the need to determine the same information. There is simply no motivation to one of ordinary skill in the art to modify the McGlone patent as suggested in the office action.

Further, the McGlone patent does not disclose, teach, or suggest determining the type of encoder (used for indicating reel position) with the reel controller and using the reel controller to compare the determined type of the encoder with the configuration data. Again, the McGlone patent discloses that type of position sensor is stored in a memory of the reel peripheral. *Id.*

Thus, the Appellant respectfully submits that claims 23 and 27 are patentable over the McGlone patent under 35 U.S.C. § 103(a).

<div align="center">REJECTION OF CLAIM 28</div>

The Examiner's Answer maintains the rejection of claim 28 based upon the Examiner's "two-McGlone-embodiments" theory. As established in connection with the discussion of claims 1-5, 7-23, and 27, the McGlone patent does not disclose two embodiments wherein device drivers are stored with the CPU in one embodiment, and configuration data are stored with the peripheral controller in another embodiment. Rather, McGlone discloses that these two aspects are part of the same embodiment and, thus, the McGlone patent discloses that configuration data is stored with the peripheral controller. Thus, claim 28, which requires *inter alia* that configuration data is sent from the CPU to the reel controller, is patentable over McGlone for at least this reason.

The Examiner's Answer raises a new point of argument by citing to a new portion of the McGlone patent—FIG. 7, Step 730, and Col. 16, lines 17-43—to support the assertion that the McGlone patent discloses the master gaming controller determines what type of encoder is present. Initially, the Appellant respectfully traverses this new point of argument. *See* 37 C.F.R. § 1.193(a)(2) ("prohibiting any new grounds of rejection in an examiner's answer"); *See also* M.P.E.P. § 1208.01. Further, the Appellant respectfully submits that this is a mischaracterization of the McGlone patent. The cited passage merely describes establishing communications between the master gaming controller and the peripheral controller. There is nothing in the cited passage or anywhere else in the McGlone patent that would teach or suggest "determin[ing] the type of encoder present <u>with the reel controller</u>" as required by the Appellant's claim 28.

The Examiner's Answer raises further new points of argument by citing to another new portion of the McGlone patent—Block 700 of FIG. 7—to support the assertion that the McGlone patent discloses running diagnostics on the reel controller which includes the reel controller "causing a motor to spin said reel and detecting a physical characteristic of said encoder." The cited passage merely refers to executing self-diagnostics to confirm the peripheral is operating properly. There is nothing in the cited passage or anywhere else in the McGlone patent that would teach or suggest the reel controller "causing a motor to spin said reel and detecting a physical characteristic of said encoder" as required by the Appellant's claim 28.

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Therefore, the Appellant respectfully submits that claim 28 is patentable over the McGlone patent under 35 U.S.C. § 103(a).

<u>REJECTION OF CLAIM 29</u>

Initially, the Examiner's Answer appears to be introducing a new basis for rejecting claim 29 by stating that claim 29 would be obvious in view of the McGlone patent alone (without the Sakamoto patent). Any new basis for rejecting claim 29 introduced in the Examiner's Answer would be improper and should not be considered. *See* 37 C.F.R. § 1.193(a)(2) (prohibiting any new grounds of rejection in an examiner's answer); *See also* M.P.E.P. § 1208.01. Claim 29 requires, *inter alia*, that the CPU issues high-level commands to said reel controller for informing said reel controller of an acceleration or deceleration profile. As pointed out in the Examiner's Answer, the McGlone patent alternatively discloses: (a) the master gaming controller may issue low-level instructions directly to the stepper motor; or (b) the master gaming controller issues a high-level instruction to the slot reel controller to move the slot reel (*e.g.*, "move the slot reel to position A"). *See* McGlone at col. 9, lines 23-57.

In the first situation, the McGlone master gaming control sends low-level instructions directly to the stepper motor. In the second situation, the McGlone master gaming controller sends a high level command to the reel control (*e.g.*, "move the slot reel to position A"). This high-level command, however, does not inform the reel controller of an acceleration or deceleration profile as required by claim 29; rather, the McGlone high-level command merely directs the reel controller to move the reel. Respectfully, the Examiner's statement that the McGlone high-level instruction—"move the slot reel 420 to position A"—informs the reel controller to move the reel "in a certain preprogrammed direction and at a certain pre-programmed rate" is wholly unsupported by the disclosure of the McGlone patent. This high-level instruction informs the reel controller nothing with respect <u>how</u> to move the reel, it only provides an instruction to move the reel.

Thus, the McGlone patent teaches away from the Appellant's claim 29. *See Monarch Knitting Mach. Corp.*, 139 F.3d at 885, 45 U.S.P.Q.2d at 1984 (Fed. Cir. 1998) (A prior art reference may be considered to teach away when "a person of ordinary skill, upon reading the reference, would be discouraged from following the path set out in the reference, or would be led in a direction divergent from the path that was taken by the applicant.")

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The Examiner's Answer indicates that the Sakamoto patent is more explicit in its teaching of acceleration and declaration profiles than the McGlone patent. The Sakamoto patent, however, discloses nothing regarding a CPU informing a reel controller of an acceleration or deceleration profile of a reel.

Thus, the Appellant respectfully submits that claim 29 is patentable over the McGlone patent in view of the Sakamoto under 35 U.S.C. § 103(a), and is patentable the McGlone patent alone under 35 U.S.C. § 103(a).
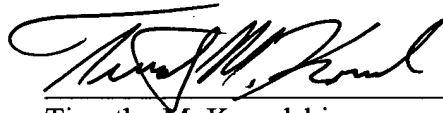
CONCLUSION

For at least the foregoing reasons, the final rejection of all the appealed claims—claims 1-5, and 7-23, 27-28, and 29—set forth in the Office Action mailed December 20, 2002 should be reversed.

The Appellant is submitting this Reply Brief in triplicate.

The Commissioner is authorized to charge any fees that may be required (except the issue fee) during the pendency of this application to Jenkens & Gilchrist, P.C. Deposit Account No. 10-0447(47079-00058).

Respectfully submitted,

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